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APPLICATION NUMBER US7288,415	FILING DATE 08/10/94	FIRST NAMED APPLICANT BRUGGER	ATTORNEY DOCKET NO. F 471965SA
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HM22/0319

EXAMINER

BAWA, R

ART UNIT

PAPER NUMBER

1615

24

DATE MAILED: 03/19/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on 2-2-99
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- Claim(s) 2-15 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 2-15 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claims _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

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Detailed Action

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gennaro, in view of Stetz et al. Gennaro discloses aerosol containers having protective coatings (p. 1670). Some examples of such coatings include oleoresin, phenolic, vinyl or epoxy coatings. It further discloses valves analogous to those

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claimed. Stetz et al. disclose aerosol delivery devices with metering devices analogous to those claimed.

It would be *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the “protective coatings” of Gennaro in the Stetz et al. delivery device and obtain the claimed aerosol container. The motivation to incorporate these “protective coatings” is obtained from the fact that “epoxy coatings” (Gennaro) can be employed as “protective coatings” (Gennaro) in delivery devices analogous to those of Stetz et al. Hence, both the motivation and reasonable expectation of success is present in the prior art cited.

Note that (i) a comprising-type language does not exclude other steps, elements or materials. *Cues Inc. Vs. Polymer Industries*, U.S.P.Q. 2d 1847 (DC ND GA 1988); (ii) it is well established that the claims are given the broadest interpretation during examination; (iii) a conclusion of obviousness under 35 U.S.C. 103(a) does not require absolute predictability, only a reasonable expectation of success; and (iv) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969). Note that the compounds disclosed by Gennaro would

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make obvious "a plastic coating". Once again note that references are evaluated by what they suggest to one of ordinary skill in the art rather than their specific disclosure. In response to applicant's argument that Gennoro could not have been combined with Stetz et al., the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871 (CCPA 1981).

The cited art is clearly analogous because it both pertains to the field of the inventor's endeavor and is also reasonably pertinent to the particular problem with which the inventor is involved *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 1443 (Fed. Cir. 1992).

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Raj Bawa, Ph.D., whose telephone number

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is (703) 308-2423. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



RAJ BAWA, Ph.D.
PRIMARY EXAMINER
GROUP 1600

BAWA; aco
March 16, 1999
March 18, 1999